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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,048	02/21/2002	Tadashi Kitamura	032887-007	9296

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EXAMINER

MAKI, STEVEN D

ART UNIT PAPER NUMBER

1733

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,048

Applicant(s)

KITAMURA ET AL.

Examiner

Steven D. Maki

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004 and 27 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 4 and 6-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1) The amendment filed 6-28-04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: (1) the curing agent containing one or a mixture of two or more selected from "a tetrafunctional mercapto compound, a modified polymercapto derivative, a microencapsulated imidazole compound, or a methyl methacrylate adduct of an alicyclic diamine"; (2) the omissions of the weight percent ranges; and (3) the units of "Ms/m" (an apparent typographical error) instead of --mS/m--.

The original disclosure fails to reasonably convey using "tetrafunctional mercapto compound, a modified polymercapto derivative" *in combination with* "a microencapsulated imidazole compound, or a methyl methacrylate adduct of an alicyclic diamine". The original disclosure also fails to reasonably convey using "a microencapsulated imidazole compound, or a methyl methacrylate adduct of an alicyclic diamine" for the two component embodiment *instead of* the one component embodiment.

The original disclosure fails to reasonably convey using weight percent ranges outside the originally disclosed and specified ranges (e.g. using 5% or 95% by weight instead of 15-84% by weight of a liquid epoxy resin) and thereby fails to reasonably convey omitting the weight percent ranges.

The abstract filed 6-28-04, appears to correspond to the abstract written by the Japanese Patent Office. See PCT/ISA/210 dated 10-2-01. This abstract is not part of

the original disclosure. See MPEP 1893.01(c), top right column on page 1800-186, Rev. 2, May 2004.

Applicant is required to cancel the new matter in the reply to this Office Action.

2) No rejections to the claims are required by the above 132 objection, since the new matter is only found in the abstract filed 6-28-04.

3) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4) Claims 3-4 and 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan '743 (JP 11-246743) in view of the admitted prior art (specification pages 1-2), Japan '425 (JP 62-133425), Takimoto et al (US 4882216) and Japan '721 (JP 61-127721).

Japan '743, the admitted prior art, Japan '425, Takimoto et al and Japan '721 are applied as in paragraph 11 of the last office action (paragraph 11 of the last office action is incorporated herein by reference).

Applicant argues that the examiner's conclusion that it would have been obvious to provide the disclosed sealant composition of Japan '743 as a two-component epoxy resin composition is inconsistent with the contention that the claims of Group II drawn to a sealant composition comprising a two-component epoxy resin composition is substantially different from the subject matter of Group III relating to a sealant composition comprising a one-component epoxy resin composition. This argument is

Art Unit: 1733

not persuasive for the simple reason that (1) the curing agent of non-elected Group III (i.e. "a curing agent being a microencapsulated imidazole compound or a methyl methacrylate adduct of an alicyclic diamine") is not required by the invention of elected Group II and (2) the curing agent of elected Group II ("a curing agent being tetrafunctional mercapto compound or modified polymercapto derivative") is not required by the invention of non-elected group III. With respect to applicant's use of the word "allegedly" before "admitted prior art", it is noted that applicant fails to assert that the subject matter described at page 2 lines 14-20 is not prior art.

Applicant argues that Japan '721 only relates to treatment of a cresol novolak epoxy resin and there is nothing in the document, which would lead those of ordinary skill in the art to subject a curing agent to filtration with an ultra filter in order to obtain the claimed ionic conductivity. Applicant's argument is not persuasive. Japan '743's epoxy composition seals and thereby contacts liquid crystal material of a liquid crystal display panel (part of an electronic / electrical device). Japan '721's teaching to remove impurities such as free ions from epoxy resin, which will be in contact with semiconductor chips such as IC, LSI, etc. (part of an electrical / electronic device), motivates one of ordinary skill in the art to remove impurities from Japan '743's epoxy composition which contains epoxy resin *and* the curing agent. This is especially true since it is well known / conventional per se in the liquid crystal display art that ions in the liquid crystal display deteriorate the liquid crystal material as evidenced by the official

notice set forth in the last office action and not challenged by applicant.¹ In other words, Japan '721's teaching to remove impurities from epoxy resin reasonably suggests removing impurities from both epoxy resin and curing agent of the epoxy composition of Japan '721. One of ordinary skill in the art would readily understand from (a) Japan '721's teaching to purify epoxy resin and (b) Japan '743's teaching to combine curing agent with epoxy resin to form the epoxy resin composition that the desired solution of a purified epoxy resin composition for avoiding the ion problem cannot be obtained if the epoxy resin is contaminated with curing agent which is not purified.

Remarks

5) Applicant's election of Group II, claims 3,4 and 6-14 in the reply filed on 6-28-04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Since the certified copy of applicant's priority document and the English translation of applicant's priority document filed 7-27-04 has been received, applicant has perfected his 119 foreign priority claim and the 103 rejections in the last office action based on Kitamura (US 6555187 or JP 2000-347203) have been withdrawn.

With respect to the 103 rejection based on Japan '743, Applicant's arguments filed 7-27-04 have been fully considered but they are not persuasive for the reasons given above.

6) No claim is allowed.

¹ The suggestion to address the ion problem by removing impurities from the epoxy comes from Japan

Art Unit: 1733

- 7) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

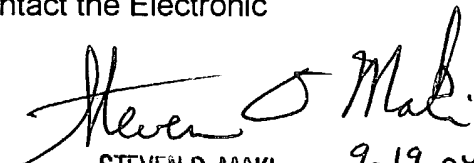
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

- 8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven D. Maki
September 19, 2004


STEVEN D. MAKI
PRIMARY EXAMINER
~~GROUP 1300~~
Av 1733
9-19-04